

The opinion in support of the decision being entered today is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FUMIYOSHI URANO, MASA AKI NAKAHATA,
HIROTOSHI FUJIE and KEIJI OONO

Appeal 2007-0686
Reexamination Control 90/004,812
Application 09/810,650
Technology Center 1600

Decided: May 11, 2007

Before CAROL A. SPIEGEL, MICHAEL P. TIERNEY, and SALLY G.
LANE, *Administrative Patent Judges*.

SPIEGEL, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the
Examiner's final rejection of reissue claims 8-11. Reissue claim 7, the only

Appeal 2007-0686
Reexamination Control 90/004,812
Application 09/810,650

other pending claim in this appeal, has been indicated as allowable.¹ We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

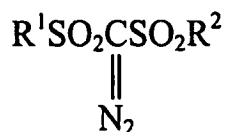
Introduction

U.S. Patent 5,216,135 (the '135 patent) was issued to Urano et al. on June 1, 1993, based on application 07/962,089, filed October 16, 1992, which is said to be a continuation of application 07/646,909, filed January 28, 1991. The '135 patent is assigned to Wako Pure Chemical Industries, Ltd. (Wako) and is directed to compounds useful in manufacturing semiconductor devices and claims certain diazodisulfone compounds useful as photosensitive materials. A request for reexamination by a third party was filed on October 23, 1997 and the reexamination proceeding was assigned control number 90/004,812. Wako filed a reissue application on March 15, 2001 which was assigned application number 09/810,650. The reexamination and reissue proceedings were merged on November 7, 2001.

Appellants admit that reissue claims 8 and 10 are duplicates and reissue claims 9 and 11 are duplicates (Appeal Br. 18, filed April 27, 2006) and state that claims 10 and 11 "will be canceled when all claims are allowed" (Appeal Br. 20). Thus, the claims on appeal recite diazodisulfone compounds of the general formula

¹ An amendment filed June 1, 2006 canceling reissue claims 12-35 was entered by the Examiner July 5, 2006 (see Advisory Action mailed July 5, 2006). Thus, only reissue claims 7-11 are currently pending in this merged reissue/reexamination proceeding.

Appeal 2007-0686
Reexamination Control 90/004,812
Application 09/810,650



wherein R¹ and R² are either both cyclic hexyl (claims 8 and 10) or both branched butyl (claims 9 and 11), i.e., a specific compound and a narrow subgenus. The Examiner relies on a single reference in her rejections:

Pawlowski

US 5,338,641

Aug. 16, 1994
(filing date Sep. 7, 1990)

Issues²

Claims 8-11 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Pawlowski (Answer 5, issued July 26, 2006). Claims 9 and 11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Pawlowski (Answer, 6). The dispositive question before us is whether Appellants are entitled to 35 U.S.C. § 119 benefit of the filing date of Japanese patent application 2-019614, thereby antedating Pawlowski as a reference and rendering the rejections moot.

Discussion

We have carefully considered all of the arguments advanced by Appellants as set forth in their Brief and Reply Brief, filed April 27, 2006

² Appellants' Brief presents arguments seeking to expunge papers from the record (Appeal Br. 12). This issue relates to petitionable subject matter under 37 C.F.R. § 1.59 and not appealable subject matter. See Manual of Patent Examining Procedure, § 1002.02 (b) (eighth edition, revision 5, August 2006).

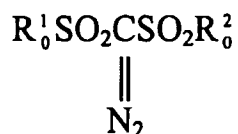
Appeal 2007-0686
Reexamination Control 90/004,812
Application 09/810,650

and September 26, 2006, respectively, and by the Examiner as set forth in the Answer mailed July 26, 2006.

Appellants argue that they are entitled to 35 U.S.C. § 119 benefit of the January 30, 1990 filing date of Japanese patent application 2-019614 (the Japanese application³), thereby antedating Pawlowski as a reference and rendering the rejections moot (Appeal Br. 18). The Examiner contends that the Japanese application fails to provide adequate written support for the subject matter of claims 8-11 (Answer 11-14). Therefore, the dispositive question before us is whether the Japanese application provides an adequate description of the particular species and the narrow subgenus of diazodisulfone compounds recited in claims 8-11.

"The function of the description requirement is to ensure that the inventor had possession, as of the filing date of the application relied on, of the specific subject matter later claimed by him." *In re Wertheim*, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976).

The Japanese application discloses (sentence bridging 8-9) photosensitive compounds represented by formula [I]



wherein R_0^1 and R_0^2 are independently a C_{1-10}
straight-chain, branched or cyclic alkyl group, C_{1-10}

³ In this decision, we will refer to the certified English language translation of Appellants' priority document made of record as part of the Appeal Brief filed on January 28, 1999 as "the Japanese application."

Appeal 2007-0686
Reexamination Control 90/004,812
Application 09/810,650

haloalkyl group, C₂₋₁₀ alkenyl group, phenyl group, substituted phenyl group (with substitutional group of halogen atom, C₁₋₁₀ straight-chain, branched or cyclic alkyl group, C₁₋₁₀ straight-chain or branched alkoxy group, C₁₋₁₀ haloalkyl group, nitro group, nitrile group or amide group), aralkyl group or substituted aralkyl group (with substitutional group of halogen atom, C₁₋₁₀ straight-chain, branched or cyclic alkyl group, C₁₋₁₀ straight-chain or branched alkoxy group, C₁₋₁₀ haloalkyl group, nitro group, nitrile group or amide group).

Thus, R₀¹ and R₀² can independently be chosen from any of seven groups.

The Japanese application further discloses that R₀¹ and R₀² chosen from the first group include "C₁₋₁₀ alkyl groups such as methyl, ethyl, propyl, butyl, amyl, hexyl, octyl and decyl group" (p. 14, ll. 5-10).

The Examiner contends that the definition of "alkyl" together with the disclosure of the various groups that could define R₀¹ and R₀² in the Japanese application does not provide adequate written descriptive support for or guidance toward the specific compound of claims 8 and 10 or for the subgenus of claims 9 and 11 (Answer, para. bridging 11-12). Appellants essentially argue that if the specifically claimed compounds of claims 8-11 are discernable from the disclosure of the Japanese application, the claims are adequately supported (Appeal Br. 9).

Appeal 2007-0686
Reexamination Control 90/004,812
Application 09/810,650

Opinion

In order to satisfy the written description requirement, the disclosure does not have to provide ipsis verbis support for the claimed subject matter. *Fujikawa v. Wattansin*, 93 F.3d 1559, 1570, 39 USPQ2d 1895, 1904 (Fed. Cir. 1996).

Clearly, however, just because a moiety is listed as one possible choice for one position does not mean there is *ipsis verbis* support for every species or subgenus that chooses that moiety. Were this the case, a "laundry list" disclosure of every possible moiety for every possible position would constitute a written description of every species in the genus. This cannot be because such a disclosure would not "reasonably lead" those skilled in the art to any particular species. *Id.*, 93 F.3d at 1571, 39 USPQ2d at 1905.

In *In re Ruschig*, 379 F.2d 990, 154 USPQ 118 (CCPA 1967), an original claim was directed to a genus of chemical compounds having a central benzosulfonylurea structure and two variable substituents attached at specific sites on that structure, i.e., "wherein R is a member selected from the group consisting of chlorine and bromine and R₂ is a member selected from the group of alkyl-, alkenyl-, cycloalkyl- and cycloalkylalkyl radicals containing 2 to 7 carbon atoms." *Id.*, 379 F.2d at 994, 154 USPQ at 121. The claim on appeal in *Ruschig* was directed to a compound in which R was chlorine and R₂ was propyl. *Id.*, 379 F.2d at 991, 154 USPQ at 119. The specification listed n-propylamine and 18 other primary amines which could be used to form the R₂ group. *Id.*, 379 F.2d at 995, 154 USPQ at 122. The

Appeal 2007-0686
Reexamination Control 90/004,812
Application 09/810,650

court said "[w]e do not see that listing the latter [n-propylamine] with the 18 others adds anything to the initial statement that one may use an alkyl amine containing from 2 to 6 carbon atoms." *Id.* The court required more specific guidance to direct those skilled in the art to the claimed compound to satisfy the written description requirement, stating that

[i]t is an old custom in the woods to mark trails by making blaze marks on the trees. It is no help in finding a trail or in finding one's way through the woods where the trails have disappeared -- or have not yet been made, which more like the case here - - to be confronted simply by a large number of unmarked trees. Appellants are pointing to trees. We are looking for blaze marks which single out particular trees. We see none. *Id.*

Here, claims 8 and 10 recite a specific diazodisulfone compound which falls within the first of seven groups disclosed in the Japanese application. While the first group encompasses straight-chain, branched or cyclic alkyls, the alkyl of claims 8 and 10 must be cyclic. Furthermore, while the alkyls of the first group encompass alkyls such as methyl, ethyl, propyl, butyl, amyl, hexyl, octyl and decyl, the cyclic alkyl of claims 8 and 10 must be hexyl. Finally, claims 8 and 10 require R_0^1 and R_0^2 both to be cyclic hexyl.

Similarly, claims 9 and 11 recite a narrow subgenus of diazodisulfone compounds which falls within the first group disclosed in the Japanese application. While the first group encompasses straight-chain, branched or cyclic alkyls, the alkyls of claims 9 and 11 must be branched. Furthermore,

Appeal 2007-0686
Reexamination Control 90/004,812
Application 09/810,650

while the alkyls of the first group encompass alkyls such as methyl, ethyl, propyl, butyl, amyl, hexyl, octyl and decyl, the branched alkyl of claims 9 and 11 must be butyl. Finally, claims 9 and 11 require R_0^1 and R_0^2 both to be branched butyl.

What the rationale in *Fujikawa* and *Ruschig* makes clear is that one cannot disclose a forest in an application and then pick a tree out of the forest absent blaze marks directing those skilled in the art to that particular tree. Appellants have not pointed us to, and we do not find, blaze marks in the Japanese application directing us to the specific compound and narrow subgenus recited in claims 8-11. Simply disclosing that R_0^1 and R_0^2 might both be same moiety, and that moiety might be either a C_{1-10} branched or cyclic alkyl, such as hexyl or butyl, in the forest of possible diazodisulfones described in the Japanese application does not reasonably lead one skilled in the art to the specifically claimed R_0^1 and R_0^2 groups which define the compound of claims 8 and 10 or the narrow subgenus of claims 9 and 11.

For the above reasons, we sustain the Examiner's decision to reject claims 8-11 under § 102(e) as being anticipated by Pawlowski and to reject claims 9 and 11 under § 103(a) as being unpatentable over Pawlowski.

Miscellaneous

Appellants contend that the Examiner has committed legal error in allegedly making a nonprecedential opinion the rule of law in the examination of claims 8-11 thereby violating Appellants' due process rights (Appeal Br. 9-12; Reply Br. 2-3).

Appeal 2007-0686
Reexamination Control 90/004,812
Application 09/810,650

First, our decision has been based on the merits of claims 8-11, although it is consistent with *In re Wako Pure Chemical Industries Ltd.* (non-precedential opinion 00-1139 issued February 1, 2001 by the Court of Appeals of the Federal Circuit). Second, the Examiner maintains that claims 8-11 have been examined on their own merits (Answer 12). Third, based on the record before us, the Examiner has provided Appellants with clear notice of the reasons underlying her unpatentability rejections of claims 8-11 under §§ 102(e) and/or 103 over Pawlowski. Moreover, Appellants have not only had the opportunity to address these rejections on their merits, but also have done so in a substantive manner. Therefore, no violation of due process is seen on the record before us.

CONCLUSION

In summary, we sustain the Examiner's decision to reject claims 8-11 under 35 U.S.C. § 102(e) as being anticipated by Pawlowski and to reject claims 9 and 11 under 35 U.S.C. § 103(a) as being unpatentable over Pawlowski.

“Not time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).”

AFFIRMED

Appeal 2007-0686
Reexamination Control 90/004,812
Application 09/810,650

Albert Tockman, Esq.
ARMSTRONG, WESTERMAN, HATTORI,
MCLELAND and NAUGHTON
Suite 1000
1725 K Street NW
Washington, DC 2007

JUDITH A. EVANS
JONES & VOLENTINE
12200 SUNRISE VALLEY DRIVE
SUITE 150
RESTON, VIRGINIA 20191

mg